

Application No. 10/800,296

Reply to Office Action

REMARKS/ARGUMENTS***Examiner Interview***

Applicants thank Examiner Fetterolf for the courtesy extended to their agent, Melissa Kolom, during an interview held on June 1, 2006. The matters discussed during the interview are substantially as set forth herein.

The Pending Claims

Claims 1-25 are pending. Claims 17-23 have been elected for prosecution pursuant to the restriction requirement. Accordingly, claims 1-16, 24, and 25 currently are withdrawn from consideration.

Requirement for Restriction and Election of Species

The Office Action alleges that the pending claims are directed to more than one invention and requires restriction of the claims to one of the following groups of subject matter:

- (I) claims 1-16, drawn to a method of treating cancer in a mammal that expresses the same level or a higher level of Wip1 comprising administering a cancer-treating effective amount of a Wip1 inhibitor,
- (II) claims 17-23, drawn to a pharmaceutical composition, and
- (III) claims 24-25, drawn to a method of determining the efficacy with which a test compound inhibits Wip1.

Applicants elect, with traverse, the claims of group II (claims 17-23), drawn to a pharmaceutical composition comprising any one of compounds A-N and a pharmaceutically-acceptable carrier.

As a second "part" to the restriction requirement, the Office Action further alleges that each of claims 4, 8, 17, 20, and 23 recite multiple compounds (A-N) and requires election of one of the compounds recited therein. The Office Action states that the claims shall be restricted to the elected compound if no generic claim is finally held to be allowable.

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Thus, in connection with the election, with traverse, of the claims of Group II, Applicants further elect, with traverse, compound H for further prosecution. Claims 17, 20, and 23 are generic to compounds A-N, and, thus, read on the elected subject matter.

Reconsideration of the requirement for restriction is respectfully requested for the reasons discussed below.

Discussion of Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (M.P.E.P. § 803).

The Office Action alleges that the subject matter of Groups I, II, and III is distinct because the separately claimed subject matter recites different steps and can utilize different products. Moreover, the Office Action states that the product defined by the claims of Group II can be used in a process that is different from those defined by the claims of Groups I and III. The Office Action concludes that a search of the claims of Groups I-III together would pose a serious burden because the required searches would not be coextensive.

The fact that a patentability search for one group of claims may not be completely "coextensive" with the patentability search for another group of claims, as the Office Action alleges, does not necessarily mean that conducting such searches concurrently would place a "serious burden" on the Examiner. Indeed, since all of the pending claims relate to compounds that inhibit Wip-1 or methods for the use of such compounds, there would be no "serious burden" on the Examiner to address all of the pending claims at one time. In the absence of such a "serious burden," the restriction requirement is improper even if groups of claims are drawn to distinct or independent inventions.

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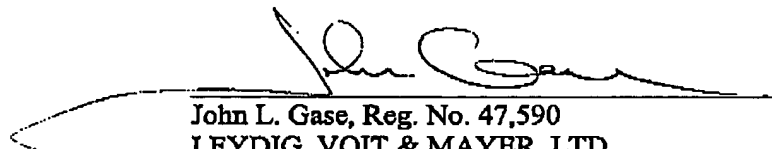
Request for Rejoinder

The Office Action has required restriction as between product claims (Group II) and process claims (Groups I and III). If the product claims are found allowable, Applicants request that any withdrawn process claims that depend from or otherwise include all of the limitations of the allowable product claims be rejoined in accordance with M.P.E.P. § 821.04.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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